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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,684	09/28/2000	Neal Goldstein	SCHB-3600 (20193)	7405
7590 11/17/2005 FARELLA BRAUN + MARTEL LLP Attn: Brian J. Keating 30th Floor 235 Montgomery Street San Francisco, CA 94104			EXAMINER BROWN, TIMOTHY M	
			ART UNIT 1648	PAPER NUMBER
DATE MAILED: 11/17/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/672,684	<b>Applicant(s)</b> GOLDSTEIN ET AL.	
	<b>Examiner</b> Timothy M. Brown	<b>Art Unit</b> 1648	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 21 and 23-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 21 and 23-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

*GP*

### DETAILED ACTION

This Final Office Action is responsive to the communication received August 18, 2005. Claims 1-7, 21 and 23-27 are under examination. Claims 8-20, 22 and 28-44 have been canceled.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

***Claims 21 and 23-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Wiecha (US 5,870,717).***

Claims 21 and 23-27 are drawn to a method for performing a financial transaction comprising receiving a customer transaction request at one of a plurality of client terminals, creating a record of said transaction request, replicating said transaction request at the plurality of client terminals, sending the transaction request to a transaction executing entity, executing the transaction request, creating a record of the executed transaction, and replicating the executed transaction record at the plurality of client terminals.

Wiecha discloses a method for conducting electronic commerce wherein one of a plurality of users at a first entity operates a computer to create an order (col. 3, lines 18-35; col. 5, line 5; col. 7, lines 61-62; col. 8, lines 14-17; and col. 9, line 1). The order then undergoes an approval process wherein the order is sent (i.e. written to) to at least one other user from the plurality of users (col. 3, lines 33-34 and 39-43; col. 5, lines 5-6; col. 7,

lines 64-65; col. 8, lines 14-19; and col. 9, lines 11-14 and 22). After receiving and approving the order, at least one of the other users approves the order whereupon it is sent to a second entity for fulfillment (col. 3, lines 43-44; col. 5, lines 4-6; col. 8, lines 16-22; and col. 9, lines 47-48). The second entity satisfies the order and sends an order confirmation to the plurality of users from the first entity (col. 10, lines 39-42). The method also provides that the plurality of users may cancel or otherwise update a submitted order (col. 9, lines 60-61 and col. 10, lines 2-3). Based on this disclosure, Wiecha anticipates the method of claims 21 and 23-27.

The rejection of claims 21 and 23-27 under Wiecha is based on new grounds which were necessitated by amendment.

**Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 4,980,826 to Wagner.**

Claims 1-7 are interpreted as being drawn to an electronic commerce system comprising a plurality of customer facing utility systems, a firm side system, and a plurality of street side systems. The plurality of customer facing utility systems, the firm side system, and the plurality of street side systems each have a set of associated data, as well as a means for replicating the associated data between the different system types, as well as between the individual systems.

It is worth noting that the following limitations do not carry patentable weight:

“said customer facing utility systems being adapted to communicate with customer systems” (e.g. claim 1); and

“each of said street side systems being adapted to communicate with street systems” (e.g. claim 4).

These limitations do not carry patentable weight because they do not provide the claimed electronic commerce system with a physical limitation. Moreover, the claims do not

Art Unit: 1648

positively recite a "customer system" or a "street system." Thus, adapting the claimed systems to communicate with these unrecited features cannot provide Applicant's invention with a physical feature that is worth consideration.

Based on this construction, Wagner anticipates claims 1-20 and 28-43 by disclosing a computerized exchange system comprising a plurality of remote terminals (col. 7, lines 42-46; and Fig. 1, chars. 18 and 20), a central processor (col. 7, lines 28-30; and Fig. 1), and a plurality of vendor systems (Fig. 15, char. 592).

**Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 4,799,156 to Shavit et al..**

Claims 1-7 are interpreted as noted above. Shavit et al. disclose a plurality of intelligent buyer terminals (i.e. customer facing systems), a plurality of intelligent seller terminals (i.e. street side systems), and an interactive market management system (i.e. firm system) (col. 5, lines 20-37; and Fig. 2). Shavit et al. further provide that each of the listed components is coupled to a communication network and that the listed terminals are capable of accessing a mass storage device (col. 5, lines 46-52). Based on the foregoing, Shavit et al. anticipates the subject matter of claims 1-7.

**Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,270,922 to Higgins.**

Claims 1-7 are interpreted as noted above. Higgins discloses a hierarchy of data processing terminals comprising area, branch and workstation levels (col. 1, lines 39-45). Storage media at the different levels disseminate data over a communication network (col. 1, lines 39-45). The data may be stored in a read only format (col. 2, lines 18-25). Based on this disclosure, Higgins anticipates the subject matter of claims 1-7.

**Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat.**

**No. 5,375,055 to Togher et al..**

Claims 1-7 are interpreted as noted above. Togher et al. disclose an anonymous trading system comprising a first market access node, in communication with a first plurality of trader workstations (i.e. customer facing utility systems), a second market access node in communication with a second plurality of trader workstations (i.e. street side systems), and an arbitrator processing node (i.e. firm side system) in communication with said first and second market access nodes (Fig. 1; col. 5, lines 1-9, 15-19, 25-27, and 39-50; col. 11, lines 7-11; and col. 12, lines 31 et seq.). Based on the foregoing, Togher et al. anticipates the subject matter of claims 1-7.

**Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat.**

**No. 6,269,343 B1 to Pallakoff.**

Claims 1-7 are interpreted as noted above. Pallakoff anticipates the Claims 1-7 by disclosing an online marketing system and method comprising:

a plurality of buyer client terminals with associated data (i.e. "customer facing utility systems") (Fig. 1, chars. 14a-14x; Fig. 9, chars. 96 and 97; col. 3, lines 22-27; and col. 4, lines 45-53);

a system controller with associated data (i.e. firm side system) (Fig. 1, char. 13b; and col. 3, lines 11-21); and

a plurality of seller client terminals with associated data (i.e. street side systems) (col. 3, lines 5-10).

Pallakoff also meets Applicant's variously recited "means for replicating data." This follows because each of Pallakoff's components referenced above is coupled to a communication network (see col. 2, lines 64-67).

Art Unit: 1648

**Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat.**

**No. 6,021,470 to Frank et al..**

Claims 1-20 and 28-43 are interpreted as noted above. Frank et al. disclose a data caching architecture comprising a central disc array (i.e. firm side system), a first plurality of workstations, and a second plurality of workstations, wherein the central disc array, first plurality of workstations, and second plurality of workstations are connected by a communication network (Fig. 1; col. 3, lines 41-61; and col. 4, lines 37-49). The first and second plurality of workstations are intelligent workstations having processing capabilities (col. 4, lines 36-49). Based on this disclosure, Frank et al. anticipates the subject matter of claims 1-20 and 28-43.

**Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat.**

**No. 6,446,048 B1 to Wells et al..**

Claims 1-7 are interpreted as noted above. Wells et al. disclose a Web-based system for financial transaction information comprising a plurality of intelligent client computers (i.e. customer facing utility systems) in communication with a server-enabled remote database (i.e. firm side system) and a plurality of request handlers (i.e. street side systems). Each of the plurality of intelligent client computers, the serve-enabled remote database, and the plurality of request handlers have an associated set of data and the ability to transmit the associated data between the components of the system (Figs. 1a and 1b; col. 6, lines 40-67; col. 7, lines 5-18 and 30-54; and col. 9, lines 10-15 and 24-30). Based on this disclosure, Wells et al. anticipates the subject matter of claims 1-7.

**Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat.**

**No. 6,324,587 B1 to Trenbeath et al..**

Claims 1-7 are interpreted as being drawn to an electronic commerce system comprising a plurality of customer facing utility systems and a firm side system. The plurality of customer

Art Unit: 1648

facing utility systems and the firm side system each comprise a set of associated data, as well as a means for replicating the associated data between the plurality of customer facing utility systems and the firm side system. The plurality of customer facing utility systems further comprises a means for transmitting data between each customer facing utility system within the plurality of customer facing systems.

Trenbeath et al. disclose a client-based system for sharing data objects comprising a plurality of intelligent client computers (i.e. customer facing utility systems) that are in communication with one another through at least one central server (i.e. firm side system) (Fig. 3A; col. 8, lines 17-24 and 54-61). Trenbeath et al. further provide that the plurality of intelligent client computers are configured to transmit data objects between one another to accomplish the replication of data among the plurality of intelligent client computers (see e.g. abstract, lines 14-18). Based on this disclosure, Trenbeath et al. anticipates the subject matter of claims 1-7.

### ***Response to Arguments***

Applicants argue the references do not disclose the invention which is a scalable system that provides sets of data to a plurality of customer facing utility systems. The Examiner respectfully submits that the claims are not allowable over the references because (i) they are drawn to an intended use of the claimed invention, and (ii) they recite non-functional descriptive material which carries no patentable weight.

Claims 1-7 are not allowable over the prior art because they simply provide an intended use for the prior art systems. The claims recite a plurality of customer facing systems, a plurality of street side systems and a firm side system, each coupled to a firm side communication network. It is clear that the claims provide an intended use for the firm side system in that the firm side system "operates to settle orders and update account balances . . . ." Thus, the prior art systems only need to be capable of settling orders and



Art Unit: 1648

updating account balances in order to meet the claimed firm side system. The prior art references clearly meet this burden by describing network servers that are capable of processing routine financial transactions. Applicants' "street side systems" are also drawn to an intended use since they "operate to communicate with financial exchanges to execute customer orders . . . ." The cited references therefore meet the street side systems by disclosing a plurality of client terminals that are in communication with the Internet.

Claims 1-7 are drawn to non-functional descriptive material which cannot distinguish the claimed invention from the prior art. This applies to the first, second and third "types" of data in the claims. The claims state that certain data "can be written to" and that other the data comes from the firm side system or the street side system. This language fails to distinguish the claims from the prior art systems' tiered client systems which have data associated with each client. The fact that the data comes from a specific source, or that it is "writable" has no impact on the claimed system since the other claim limitations are not affected by the status of the data. Accordingly, the claimed first, second and third types of data cannot provide a patentable difference over the prior art.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened

Art Unit: 1648

statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Brown whose telephone number is (571) 272-0773. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on (571) 272-0902. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Timothy M. Brown  
Examiner  
Art Unit 1648

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